

## **II. Remarks**

### **A. Status of the Claims**

Claims 1-16 will be pending after entry of this amendment. Claims 1, 7 and 16 have been amended without prejudice. Support for the amendments can be found throughout the application as originally filed, specifically, e.g., paragraph [0025] of the specification and Figure 1. Applicants respectfully submit that no new matter has been added by virtue of this amendment.

### **B. Claim Objections**

In the Office Action, claims 1, 7 and 16 were objected to because the “claims contained optional steps”.

In response, the claims have been amended to remove the optional steps and to recite positive limitations, as suggested by the Examiner.

Accordingly, Applicants respectfully request that the claim objections be removed.

### **C. Claim Rejections under 35 U.S.C. § 101**

In the Office Action, claims 1-16 were rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. In making the rejection, the Examiner stated that “a statutory process must [] be tied to another statutory class (such as a particular apparatus)...”.

In response, the claims have been amended to recite that the claimed methods are “computer implemented” and that the pricing data is displayed “on a computer screen”. Applicants submit that the present claims are tied to another statutory class via a particular apparatus, namely, a computer.

Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 101 be removed.

## **D. Claim Rejections under 35 U.S.C. § 103**

### **1. Potter**

In the Office Action, claims 1, 4-7 and 12-16 were rejected as being unpatentable over U.S. Patent No. 5,787,402 to Potter.

This rejection is respectfully traversed. Applicants submit that the teachings of Potter fail to render obvious the computer implemented methods for pricing a trade, as presently claimed. The Examiner is reminded that pursuant to MPEP, 8<sup>th</sup> Ed., 7<sup>th</sup> Rev. § 2142, to establish a prima facie case of obviousness, and thus sustain the rejection of a claim under 35 U.S.C. § 103(a), there must be a clear articulation of the reasons why Applicants' claimed invention would have been obvious. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The Supreme Court in *KSR* has further noted that an analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit. Therefore, it is clear that an obviousness rejection "cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006). Moreover, "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP, 8<sup>th</sup> Ed. 7<sup>th</sup> Rev. § 706.02(j).

In making this rejection, the Examiner cites col. 5, lines 15-21 in combination with col. 2, lines 17-34 of Potter to support his position that Potter teaches "providing a user input for manually entering pricing data". See Office Action at page 5. First, Applicants respectfully point out that col. 5, lines 15-21 of Potter are directed to the manual entry of manual leave orders, not pricing data. Second, Applicants point out that the Examiner only cites to col. 17-34 of Potter, however, when this section is viewed in its entirety, i.e., lines 17-51, Potter teaches away from the presently claimed invention, specifically with respect to the limitation of manual entry of pricing data. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP, 8<sup>th</sup> Ed. 7<sup>th</sup> Rev.

§2141.02, citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Applicants submit that col. 2, lines 17-51, in the "Background of the Invention" section of Potter, is directed to drawbacks of the "current", i.e. prior art, process, and recites in pertinent part:

**Currently, the process is manually intensive and may comprise several layers of participation...** The trader will take down the information and then determine the price to the customer by assessing several factors including, the current "wholesale" rate of exchange between the currencies, the nature of the customer and the size of the transaction. In order to determine the price, the trader may need to communicate with another individual at the "interbank" desk....

The trader will communicate this price over the telephone and the customer will either accept it or reject it. If accepted, the trader will execute the transaction and the execution will be reflected in the customer's account.

**There are several shortcomings in the current system. First, it may be time intensive for the customer because the price is being generated manually by a trader in response to the customer's request....**

**Further, the current system is labor intensive.** Because each response to a customer is being generated by a trader, the bank must adequately staff the number of traders and this can be imperfect, leading to inefficiencies...

**There can also be a lack of uniformity. Different traders may quote different prices for the same requested transaction due to the somewhat subjective way the traders formulate the prices.**

Potter at col. 2, lines 17-51 (emphasis added).

Thus, Applicants submit a skilled artisan, viewing Potter in its entirety, would not manually enter pricing data, as Potter not only fails to teach the manual entry of pricing data, but also teaches away from manual entry of pricing data, indicating that "price [] being generated manually by a trader" is "manually intensive", "labor intensive" and has "lack of uniformity"; shortcomings of prior art methods which the Potter invention intended to overcome. See Potter at col. 3, lines 13-18.

Accordingly, as Potter teaches away from the present invention, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) over Potter be removed.

## **2. Potter in view of Finebaum**

In the Office Action, claims 2-3 and 8-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Potter in view of U.S. Publication No. 2002-0156719 to Finebaum.

This rejection is respectfully traversed. Applicants submit that the combination of Potter and Finebaum fail to render obvious the computer implemented methods for pricing a trade, as presently claimed.

As discussed *supra*, Applicants submit that Potter teaches away from the present invention, specifically with respect to the limitation of manually entering pricing data. Applicants further submit that Finebaum fails to cure the deficiencies of Potter.

Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) over Potter in view of Finebaum be removed.

### **III. Conclusion**

In view of the amendments made and arguments presented, it is believed that all claims are in condition for allowance. If the Examiner believes that issues may be resolved by a telephone interview, the Examiner is invited to telephone the undersigned at (973)597-6162. The undersigned also may be contacted via e-mail at [epietrowski@lowenstein.com](mailto:epietrowski@lowenstein.com). All correspondence should be directed to our address listed below.

### **AUTHORIZATION**

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account No. 50-1358.

Respectfully submitted,  
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